

## REMARKS

Claims 1-24 are pending in the instant application. Claims 1-24 have been rejected by the Examiner. A telephone interview with the Examiner was conducted on January 24, 2008. A discussion of independent claims 1 and 10 with respect to the rejections under 35 U.S.C. 102 did not result in an agreement between the Examiner and the Applicants' undersigned representative. In response to the Office Action, claims 1-24 have been amended. The Applicants submit that claims 1-24 are in condition for allowance and respectfully request reconsideration and withdrawal of the outstanding rejections. No new matter has been entered.

### Claim Rejections Under 35 USC §102 and 35 USC §103

Claims 1-4, 6, 8, 9-13, 15, 17-22 and 24 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Publication No. 2002/0046093 to Miller, et al. (hereinafter "Miller"). In addition, claims 5 and 14 have been rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Miller in view of U.S. Patent No. 6,061,682 to Agrawal. Also, claims 7, 16, and 23 have been rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Miller in view of Official Notice.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the \* \* \* claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With respect to independent claims 1-4, 6, 8, 9-13, 15, 17-22, and 24, the Applicants traverse the outstanding rejections under 35 U.S.C. 102(b) because Miller does not teach or suggest *each and every element* recited therein.

Independent claims 1, 10, and 19 have been amended to better clarify that which is regarded as the Applicants' invention. In particular, claims 1, 10, and 19 have been amended to recite, *inter alia*, "performing analysis of electronic activities conducted by a network user;

inferring an intent to execute a transaction by the network user, *the inference based upon results of the analysis and absent any explicit action by the network user to execute the transaction*; and

*automatically* executing the transaction on behalf of the network user.”

No new matter has been entered by these amendments. Support may be found throughout the Applicants’ specification and drawings. In particular, support for “the inference based upon results of the analysis and absent any explicit action by the network user to execute the transaction” may be found, e.g., on page 3, paragraph [0010], which relates to purchases as transactions and states, “[p]urchases are *inferred* based upon previous purchasing activities and customer prescribed preferences *whereby no explicit purchasing action* is required by the customer” (emphasis added). As claimed, the inference is based upon results of the analysis. Support for the analysis-derived inference may be found, e.g., paragraphs [0014] through [0022], which describe the various modules and databases used to collect and analyze a user’s electronic activities in view of user-defined policies.

In addition, support for “*automatically* executing the transaction *on behalf of* the network user” may be found, e.g., in paragraph [0023], which states “the purchasing system allows for *automatic* purchasing of products and services based upon the policy decisions established by the individual or organization and past activities” (emphasis added). As indicated above, the policies and past activities are described in paragraphs [0014] through [0022], as well as the flow diagram of Figure 2.

These features are neither taught, nor suggested, by Miller. Miller makes no inferences regarding whether a network user intends to execute a transaction. The inference, as provided by the Applicants’ specification (see, e.g., page 3, paragraph [0010]), is based upon *previous activities and customer preferences* and *does not require any explicit action by the customer*. There is not a single reference to “infer” or “inference” within the Miller reference. In the Office Action, the Examiner references paragraph [0157] of Miller for allegedly disclosing this feature. However, this portion of Miller teaches that a process (900) receives a *textual request* for information about an item and matches products to the textual request. If the Examiner is suggesting that the process 900 infers that a user desires to purchase the item based upon the

textual request for information, this interpretation is in error. The process 900 simply retrieves and outputs information in response to a direct request (the textual request) from the user (paragraph [0157]). There is clearly no teaching that the process in Miller infers that the user wishes to purchase a product in response to the textual request for information.

Notwithstanding, the Applicants' amendments to claims 1, 10, and 19 further clarify the nature of the inference, namely, "the inference based upon the analysis and absent any explicit action by the network user to execute the transaction." As indicated above, Miller does not teach inferring an intent by a network user to execute a transaction. Further, Miller requires explicit actions by the user either by request (e.g., textual request for information) or acknowledgement of a purchase.

For at least the above reasons, the Applicants submit that independent claims 1, 10, and 19 are not anticipated by Miller and are in condition for allowance. Claims 2-9, 11-18, and 20-24 should be in condition for allowance for at least the reason they depend from respective allowable claims 1, 10, and 19. Thus, the introduction of, and reliance upon, Agrawal and Official Notice for the rejections of claims 5, 7, 14, 16, and 23 would not cure the aforementioned deficiencies of Miller. For at least these reasons, the Applicants submit that claims 2-9, 11-18, and 20-24 are in condition for allowance. Reconsideration and withdrawal of the outstanding rejections is respectfully requested.

### CONCLUSION

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested. It is submitted that the foregoing amendments and remarks should render the case in condition for allowance.

Accordingly, as the cited references neither anticipate nor render obvious that which the applicant deems to be the invention, it is respectfully requested that claims 1-24 be passed to issue.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,  
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